

ESTTA Tracking number: **ESTTA536492**

Filing date: **05/06/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91198858
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Attachments	Applicant's Brief (2013-5-2) CaseCentral v. Nextpoint.pdf (25 pages)(133919 bytes)

CASECENTRAL, INC.,)	Mark: PRESERVATION
)	CLOUD
Opposer,)	Serial No.: 77/922,469
v.)	Opposition No. 91198858
NEXTPOINT, INC.)	Published in the Official
)	Gazette on November 9, 2010
Applicant.)	

Table of Contents

INTRODUCTION	1
SUMMARY OF THE RECORD.....	2
STATEMENT OF FACTS	2
I. Nextpoint’s development of its “Cloud” suite of litigation support tools	2
II. Development of CloudPreservation service	3
III. Nextpoint, Inc. v. CaseCentral, Inc. federal litigation	4
IV. Registration of TRIAL CLOUD and DISCOVERY CLOUD marks and publication of PRESERVATION CLOUD mark	4
ARGUMENT	4
I. “Abandonment” of an intent to use a mark is not a proper basis for opposition.....	4
II. Opposer has not proved that Nextpoint abandoned its intent to use the mark	5
A. A lack of documentary evidence does not necessarily prove a lack of bona fide intent, and Applicant has presented ample documentation of its intent to use the Mark.	6
B. Preservation Cloud and CloudPreservation are different services	8
III. Applicant’s Mark is suggestive rather than descriptive of Applicant’s services.....	10
A. “Cloud” is not a meaningful description of Applicant’s services	11
B. PRESERVATION CLOUD is a unitary expression that lacks any readily ascertainable meaning.....	13
C. Any doubts regarding the descriptiveness of the mark should be resolved in favor of the Applicant.	19
CONCLUSION.....	20

Table of Authorities

Cases

<i>Anheuser-Busch, Incorporated v. Kelly J. Holt</i> , Opp. No. 91180119 (T.T.A.B. 2009)	12
<i>Blair Corp. v. Fassinger</i> , Opp. No. 91166414 (T.T.A.B. Oct. 17, 2008).....	7
<i>Bobosky v. adidas AG</i> , 843 F. Supp. 2d 1134 (D. Or. 2011)	6
<i>Commodore Elecs. Ltd. v. Cbm Kabushiki Kaisha</i> , 26 U.S.P.Q. 2d 1503 (T.T.A.B. 1993)	
.....	4, 6
<i>Estate of P.D. Beckwith, Inc. v. Commissioner of Patents</i> , 252 U.S. 528 (1920).....	13
<i>Galaxy Metal Gear, Inc. v. Direct Access Technology, Inc.</i> , Opp. No. 91184213	
(T.T.A.B. 2010)	13
<i>Goodyear Tire & Rubber Co. v. Continental General Tire Inc.</i> , 70 USPQ2d 1067	
(T.T.A.B. 2003)	11
<i>iMedica Corporation v. Medica Health Plans</i> , Opp. No. 92043288	
(T.T.A.B. June 7, 2007)	7
<i>In re Bayer Aktiengesellschaft</i> , 488 F.3d 960 (Fed.Cir.2007)	11
<i>In re Dial–A–Mattress Operating Corp.</i> , 240 F.3d 1341 (Fed.Cir.2001).....	12
<i>In re Fazzari Restaurant Group LLC</i> , Ex Parte Appeal No. 77109197 (T.T.A.B. 2010) ..	14
<i>In re Gourmet Bakers, Inc.</i> , 173 U.S.P.Q. 565 (T.T.A.B. 1972)	20
<i>In re Gyulay</i> , 820 F.2d 1216 (Fed.Cir.1987)	11
<i>In re K2, Inc.</i> , Ex Parte 75916474 (T.T.A.B. 2003)	14
<i>In re Merrill Lynch, Pierce, Fenner and Smith</i> , 4 U.S.P.Q.2d 1141 (Fed. Cir. 1987)	20
<i>In re Penwalt Corp.</i> , 173 U.S.P.Q. 317 (T.T.A.B. 1972)	20
<i>In re Reynolds Metals Company</i> , 480 F.2d 902, 178 USPQ 296 (C.C.P.A. 1973)	12
<i>In re Women’s Publishing Co.</i> , 23 U.S.P.Q.2d 1876 (T.T.A.B. 1992).....	20
<i>Intel Corp. v. Emeny</i> , No. 91123312 (T.T.A.B. May 15, 2007)	5
<i>Kellogg Co. v. The Earthgrains Co.</i> Opp. No. 91110121 (T.T.A.B. Sept. 30, 2003)	7
<i>Lane Ltd. V. Jackson Int’l Trading Co.</i> , 33 USPQD.2d 1351, 1352 (T.T.A.B. 1994)	5
<i>Paddington & Co. v. Lead Co.</i> , Opp. No. 91150248 (T.T.A.B. Mar. 19, 2004)	8
<i>Pfizer, Inc. v. Hamerslag</i> Opp. No. 9118181 (T.T.A.B. Sept. 27, 2001)	7
<i>Speedway Superamerica LLC v. Renegade Tobacco, Inc.</i> , Opp. No. 91124822	
(T.T.A.B. June 10, 2004)	5, 7

Treatises

J. Thomas McCarthy, <u>McCarthy on Trademarks and Unfair Competition</u> (4th Ed. 1999)	
.....	12, 14, 20

Statutes

15 U.S.C. § 1051(b)	9
15 U.S.C. §1052(e)(1).....	10
37 CFR § 2.122(b)	2

Applicant Nextpoint, Inc. (“Nextpoint”) by and through its attorneys, hereby submits the following Final Brief on the Merits of the Case.

Introduction

Opposer CaseCentral, Inc. (“CaseCentral,” “Opposer”) opposes registration of Applicant’s mark PRESERVATION CLOUD (the “Mark”) on two grounds: (1) that Applicant abandoned its intent to use the mark subsequent to filing its application on an intent-to-use basis; and (2) that PRESERVATION CLOUD merely describes Applicant’s data-organizing services. Both arguments are without merit.

Opposer’s intent-not-to-use argument fails for two reasons. First, it is not a proper basis for opposition. Opposer’s Notice of Opposition does not allege that Nextpoint lacked a *bona fide* intent to use the trademark at the time of its application, which is all the Trademark Office requires of an application made pursuant to Section 1051(b). An alleged decision not to use a trademark, supposedly made subsequent to filing the application but before the deadline for filing a Statement of Use, is not grounds for rejecting a trademark application.

Second, Nextpoint *does* intend to use the mark PRESERVATION CLOUD. Opposer has failed to carry its burden of proving that Nextpoint lacks such intent, since the only evidence it has put forward is (1) that, notwithstanding the copious documentary evidence on the record showing Applicant’s intent to use the mark, Applicant has allegedly failed to produce a “written plan”; and (2) that Nextpoint has a separate service called CloudPreservation. Even if Opposer had made an adequate *prima facie* case that Nextpoint lacked a genuine intent to use its trademark, this contention has been thoroughly rebutted by Nextpoint’s documentary and testimonial evidence.

Opposer’s descriptiveness argument is also unsound. The term CLOUD does not convey

any useful information about the nature of Applicant's services and therefore functions as more than mere description. Moreover, the mark as a whole creates a distinct impression which is more than the sum of its component words.

Summary of the Record

The evidentiary record consists of (1) Opposer's Notice of Reliance No. 1, submitted on October 5, 2012 ("Opp. NOR"); (2) Applicant's Notice of Reliance No. 1, submitted on December 6, 2012 ("App. NOR"); (3) the December 3, 2012 trial deposition of Nextpoint's Rakesh Madhava ("Madhava Dep."); (4) the December 3, 2012 trial deposition of Nextpoint's Michael Beumer ("Beumer Dep."); and (5) pursuant to 37 CFR § 2.122(b), the application file for the subject mark PRESERVATION CLOUD ("Subject Application").

Statement of Facts

I. Nextpoint's development of its "Cloud" suite of litigation support tools

Nextpoint is a technology developer providing litigation support services. App. NOR, Ex. 9. In late 2009 and 2010, Nextpoint was preparing to launch a suite of integrated web-based services, including Discovery Cloud, an all-in-one eDiscovery processing and review solution, and Trial Cloud, a trial practice support tool. Madhava Dep. 7:5-20; *see also* Beumer Dep. 5:2-10.

In addition, during this same period, Nextpoint was working on a service that would provide low-cost, long-term storage, organization and processing of large volumes of data ("Data Management Service"). Madhava Dep. 5:3-11; 10:14-11:1; App. NOR, Ex. 4 (press release announcing new "low-cost secure on-line storage" for "\$1 per GB per month"). In order to integrate this service with its other products, it planned to call this service PRESERVATION CLOUD. *Id.*; App. NOR, Ex. 5, 6, 8 (describing Preservation Cloud as a way to "preserve and

manage large volumes of ESI”); App. NOR, Ex. 7, 10 (pricing Preservation Cloud at \$1 per GB per month).

In preparation for using the mark PRESERVATION CLOUD in connection with the Data Management Service, Nextpoint employees began using the name internally and in brochures, blog posts, and emails to customers. Beumer Dep. 5:17-23. On January 28, 2010, Nextpoint also applied for a federal trademark registration for PRESERVATION CLOUD on an intent-to-use basis in class 39 for “Electronic storage of data” and in class 42 for:

Providing temporary use of a web-based software application for use in grid computing capacity for litigation support services and graphical presentation services, namely, image generation, viewing and manipulation, text and metadata extraction, batch file format converting, batch data uploading and downloading, search engine and search index generation, pdf generation and support, html file previewing, and mobile/smartphone compatibility

Subject Application.

While Nextpoint does provide some form of the Data Management Service to select customers and has at times referred to this service as PRESERVATION CLOUD, neither the Data Management Service nor the PRESERVATION CLOUD brand are currently being marketed alongside the company’s top-level products. Madhava Dep. 20:2-24; 22:10-24; 28:10-22. However, Nextpoint has never shelved its plans for the Data Management Service or abandoned its intent to use PRESERVATION CLOUD in connection with it. Madhava Dep. 11:8-19; 22:1-7; 22:20-24.

II. Development of CloudPreservation service

Meanwhile, Nextpoint was also developing a software service that would allow customers to automatically search for content published by or about an organization on blogs, social media platforms such as Twitter and Facebook, and other websites (“Web Archiving

Service”). Madhava Dep. 10:21-11:1; 23:21-25:6. Opp. NOR, Ex. 4. While Nextpoint may have at one time considered bundling the Web Archiving Service along with the Data Management Service under the PRESERVATION CLOUD brand, it decided for various reasons to market this product under a separate trademark, choosing the mark CLOUDPRESERVATION for this purpose. Madhava Dep. 28:23-30:1. In April, 2010, it applied for CLOUDPRESERVATION in class 42 for “Providing a web-based software application that permits the archiving, searching and exporting of information and data that is transmitted and displayed on-line.” Opp. NOR, Ex. 9. The CloudPreservation service launched in August, 2010. Beumer Dep. 12:22-24

III. Nextpoint, Inc. v. CaseCentral, Inc. federal litigation

On June 28, 2010, Nextpoint filed suit against CaseCentral in the Northern District of Illinois claiming, among other things, that CaseCentral’s use of the mark EDISCOVERY CLOUD infringed upon its CLOUD trademarks, which included, at the time, DISCOVERY CLOUD, TRIAL CLOUD and PRESERVATION CLOUD. Ntc. of Opp., ¶ 11, Opp. NOR, Ex. 16 ¶ 11. After a year of litigation, Nextpoint moved to voluntarily dismissed the suit on February 16, 2011. Ntc. of Opp., ¶ 14, Opp. NOR, Ex. 16, ¶ 14.

IV. Registration of TRIAL CLOUD and DISCOVERY CLOUD marks and publication of PRESERVATION CLOUD mark

Applicant’s TRIAL CLOUD and DISCOVERY CLOUD marks were eventually registered in class 39. Opp.’s Brief, 9. PRESERVATION CLOUD, on the other hand, was approved for publication in both class 39 and 42 on September 22, 2010. Subject Application. On March 7, 2011, Opposer filed its Notice of Opposition. *Id.*

Argument

I. “Abandonment” of an intent to use a mark is not a proper basis for opposition

Opposer admits in its pleadings that Nextpoint intended to use the PRESERVATION

CLOUD mark when it filed its January 28, 2010 application. Ntc. of Opp. ¶ 6, 17. It contends only that Nextpoint later changed its mind. Since this is not a basis for sustaining an opposition, Opposer's first argument fails to state a claim upon which relief could be granted.

The Board has acknowledged as legitimate grounds for opposition a lack of "a bona fide intention to use the mark in commerce *at the time of filing the application.*" *Speedway SuperAmerica LLC v. Renegade Tobacco Inc.*, No. 91124822, at *15 (TTAB September 2, 2004) (emphasis added). *See also Lane Ltd. V. Jackson Int'l Trading Co.*, 33 USPQD.2d 1351, 1352 (TTAB 1994); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993). Opposer has not cited any authority for sustaining an opposition on the basis that a *bona fide* intent to use was subsequently relinquished.

15 U.S.C. § 1051(b) requires only that an applicant's statement that it intends to use the Mark in commerce be made in good faith. Where an applicant later changes its mind, this issue is fully addressed by the requirement that an applicant file a Statement of Use within six months. Opposer makes much of the fact that Nextpoint has not yet filed a Statement of Use for PRESERVATION CLOUD, Ntc. of Opp. ¶ 6, but, since any requirement that it do so was suspended by the proceeding that Opposer itself filed, this allegation is irrelevant.

II. Opposer has not proved that Nextpoint abandoned its intent to use the mark

Even if Opposer's allegation was a legitimate basis on which to refuse Applicant's application, it would fail. The burden is on the opposer to establish a lack of *bona fide* intent by a preponderance of the evidence. *Intel Corp. v. Emeny*, No. 91123312, at *8 (TTAB May 15, 2007). Here, Opposer has not produced any evidence that would indicate a *lack* of intent to use PRESERVATION CLOUD, and, indeed, Applicant has produced substantial evidence that it *does* intend to use PRESERVATION CLOUD.

Opposer presents two reasons to believe that Nextpoint no longer genuinely intends to use PRESERVATION CLOUD: (1) that Nextpoint lacks a “written plan” to do so; and (2) that Nextpoint’s decision to use the mark CLOUDPRESERVATION in connection with its Web Archiving Service demonstrates an abandonment of its intent to use PRESERVATION CLOUD. *See* Opp.’s Brief 19.

A. A lack of documentary evidence does not necessarily prove a lack of *bona fide* intent, and Applicant has presented ample documentation of its intent to use the Mark.

Opposer has not carried its burden of demonstrating that Nextpoint lacks documentary evidence of its intention to use the PRESERVATION CLOUD mark, but, even if it had, Nextpoint has thoroughly rebutted this contention.

It’s true that where an opposer can demonstrate that an applicant lacks any documentary evidence whatsoever of its intent to use a mark, this provides a *prima facie* that shifts the burden to the applicant to provide an adequate explanation for the evidentiary vacuum. *Commodore Elecs. Ltd. v. Cbm Kabushiki Kaisha*, 26 U.S.P.Q. 2d 1503 (TTAB 1993). In *Commodore*, the Board found that, “[a]lthough admittedly a close question,” an absence of documentary evidence might be enough to show a lack of intent “absent other facts which adequately explain or outweigh” this absence. *Id.* at 1507.

Following *Commodore*, a district court in Oregon found that the plaintiff in *Bobosky v. adidas AG*—a case on which Opposer leans heavily—lacked a *bona fide* intent to use the mark WE NOT ME on footwear and clothing because he could produce absolutely no evidence that he had planned to do so and because he had in fact testified at his deposition that “he had ‘[n]o plans’ to create WE NOT ME clothing or footwear” at the time of his application. 843 F. Supp. 2d 1134 (D. Or. 2011).

However, numerous TTAB cases subsequent to *Commodore* have established that the

threshold for what constitutes “documentary evidence” is not as high as Opposer wishes to suggest. In *Pfizer, Inc. v. Hamerslag*, applicant’s evidence consisted entirely of “applicant’s deposition testimony and affidavit regarding his modest and informal business plan for his intended use of the mark,” and yet this did not constitute “absence of any documentary evidence” sufficient to sustain a motion for summary judgment. Opp. No. 9118181 at *5-6 (T.T.A.B. Sept. 27, 2001). In *Kellogg Co. v. The Earthgrains Co.*, the Board found applicant’s unsupported testimony that it had “prepared labels for test marketing” sufficient to show a presence of documentary evidence. Opp. No. 91110121 at *5-6 (T.T.A.B. Sept. 30, 2003). In *Blair Corp. v. Fassinger*, “despite the lack of a corroborating business plan or other documents,” applicant’s testimony that she had “undertaken steps to acquire manufacturing capabilities and promotional activities” was enough to demonstrate her *bona fide* intent to use her mark. Opp. No. 91166414 at *12 (T.T.A.B. Oct. 17, 2008). In *Speedway Superamerica LLC v. Renegade Tobacco, Inc.*, the Board found that “[a]lthough applicant [did] not have documents to show the development of this brand,” applicant’s deposition testimony that it had conducted a trademark availability search and commissioned graphic design work was enough to show an intent to use. Opp. No. 91124822 at *7 (T.T.A.B. June 10, 2004).

Furthermore, even if an opposer carries its *prima facie* burden by pointing to an absence of documentary evidence, this showing can be rebutted if circumstances exist that explain or outweigh this absence. *iMedica Corporation v. Medica Health Plans*, Opp. No. 92043288, at *40 (TTAB June 7, 2007) (finding that the applicant’s failure to produce documentary evidence was reasonable due to the uncertainty that the opposition proceeding had cast on its business plans).

Here, Opposer alleges only that “[t]he record (1) contains no ‘written plan’ by Nextpoint to use the Mark going forward.” Opp.’s Brief 19. This is a long way from establishing that Nextpoint lacks documentary evidence of its intent. First, it is not Nextpoint’s burden to supply the record with

a “written plan” or any other type of document. *See Paddington & Co. v. Lead Co.*, Opp. No. 91150248 at *25 (T.T.A.B. Mar. 19, 2004) (finding that the opposer had failed to make a *prima facie* case of non-intent simply because, although the applicant allegedly failed to produce documents supporting its *bona fide* intent, opposer “did not make applicant’s discovery responses properly of record in this case”). More importantly, Nextpoint has supplied ample documentary support for its claim that it intends to use the Mark in the form of marketing materials, press releases and blog posts published in anticipation of using PRESERVATION CLOUD in connection with Nextpoint’s Data Management Service. App. NOR, Ex. 1-11. These publications demonstrate a far firmer intention to use the Mark than would be provided by a “written plan,” the hypothetical document that Opposer insists is tellingly absent but the contents and function of which are never fully spelled out.

Even if Opposer had made a *prima facie* case that Nextpoint’s documentary evidence is insufficient, Nextpoint has rebutted this argument with its testimony that it has undertaken steps that objectively demonstrate an intent to use the Mark. Nextpoint CEO Rakesh Madhava testified as to the extensive development history of the Data Management Service. Madhava Dep. 5:3-11; 10:14-11:1. Nextpoint’s director of marketing Michael Beumer testified that the company has used the name Preservation Cloud to describe this service, both internally and in brochures, blog posts, and emails to customers. Beumer Dep. 5:17-23. To the extent that Nextpoint’s preparations to use the Mark have slowed over the last two years, this is entirely explicable. Like many companies, Nextpoint has finite resources with which to develop and market new products. As both Madhava and Beumer explained in their depositions, Nextpoint is constrained by needing to devote “additional bandwidth to finalize and finish [the Data Management Service] and push it out,” Madhava Dep. 20:2-8, and by a marketing strategy that currently focuses on clients for whom the Data Management Service was not specifically developed. Beumer Dep. 19:14-21:18.

B. Preservation Cloud and CloudPreservation are different services

Opposer's intent-to-use argument rests almost entirely on its theory, unsupported by the record, that Nextpoint's Data Management Service and its Web Archiving Service are identical products and that, upon choosing to call the latter CLOUDPRESERVATION, Nextpoint immediately lost all interest in the PRESERVATION CLOUD mark.

Even if Opposer's flawed understanding of Nextpoint's product line had some basis in fact, it is not clear how this would support its case, since nothing in 15 U.S.C. § 1051(b) prohibits a party from intending to use multiple trademarks in connection with a single product, or from phasing out one trademark in favor of another. Nevertheless, the record makes clear that Nextpoint has always associated the PRESERVATION CLOUD mark chiefly with its Data Management Service and its CLOUDPRESERVATION mark chiefly with its Web Archiving Service.

Nextpoint's testimony provides a clear, comprehensible explanation of the distinction between the two services: "Preservation Cloud is intended for clients who have large volumes of [. . .] legacy data, e-mail boxes, productivity documents, the things that constitute traditional eDiscovery, and give them a place to stage that data and have it available for processing at some point later in the future, if the matter warrants and as the matter evolves. Cloud Preservation is a service specifically to collect data from the cloud, social media platforms such as Facebook, Twitter, Utube, [sic] websites, blogs, any other content that clients may have in the cloud." Madhava Dep. 10:16-11:1. *See also* Beumer Dep. 13:1-14:23.

This explanation of the two services is supported by both parties' documentary evidence. The services are described quite differently in Nextpoint's marketing materials. App. NOR, Ex. 5, 6, 8 (describing Preservation Cloud as a way to "preserve and manage large volumes of ESI"); Opp. NOR, Ex. 4 (describing Cloud Preservation as a service that "securely archives and indexes

data from your WEBSITES, BLOGS, TWITTER and FACEBOOK” through “automated crawling”). Their pricing structures are different. App. NOR, Ex. 7, 10 (pricing Preservation Cloud at \$1 per GB per month); App. NOR, Ex. 11 (pricing CloudPreservation from \$15-\$295/month depending on the number of media “feeds” involved).

Nextpoint’s account of its products is given further credibility by the description of goods contained in the respective trademark applications for PRESERVATION CLOUD and CLOUDPRESERVATION. The former describes an application with functions designed to aid in the management of large amounts of data in long-term storage, including “image generation, viewing and manipulation, text and metadata extraction, batch file format converting, batch data uploading and downloading, search engine and search index generation, pdf generation and support, html file previewing, and mobile/smartphone compatibility.” The latter describes an application for “archiving, searching and exporting of information and data that is transmitted and displayed on-line.” Opp. NOR, Ex. 9.

Apart from their mutual integration in Nextpoint’s suite of litigation support tools, the two products have little to do with one another, and Nextpoint’s decision to call its Web Archiving Service CLOUDPRESERVATION has no bearing on its intent to use PRESERVATION CLOUD in connection with its Data Management Service.

III. Applicant’s Mark is suggestive rather than merely descriptive of Nextpoint’s Data Management Service

Opposer also alleges that PRESERVATION CLOUD is merely descriptive of Applicant’s services and that registration should therefore be refused pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1). As this conclusion is contrary to the determination of the Examining Attorney, the burden rests on Opposer to prove by a preponderance of the evidence that the Mark is descriptive. *Goodyear Tire & Rubber Co. v. Continental General Tire Inc.*, 70

USPQ2d 1067, 1070 (T.T.A.B. 2003).

Opposer's descriptiveness objection rests on its contention that PRESERVATION CLOUD "merely describes Nextpoint's use of cloud computing for the preservation of certain types of data found on the internet." (Ntc. of Opp. ¶ 18) or, alternatively, that Applicant's service "uses *cloud*-based technology for the purpose of *preserving* documents." (Opp. Brief, p. 17).

No matter how emphatically Opposer italicizes its characterization of Applicant's product, the descriptive value of the term PRESERVATION CLOUD remains minimal. The Mark is at best suggestive, since a mental leap is required to connect PRESERVATION CLOUD to software providing low-cost storage, organization and retrieval of large volumes of electronically stored information. This is because, among other things: (A) the term CLOUD does not impart any meaningful information about Applicant's services; (B) PRESERVATION CLOUD is a unitary expression that, considered as a whole, lacks any readily ascertainable meaning; and (C) any doubt as to whether a mark is descriptive must be resolved in favor of the applicant.

A. CLOUD is not a meaningful description of Applicant's services.

The presence of the term CLOUD in Applicant's Mark does little more than suggest that its services are in some way related to the Internet. While Applicant does, in a sense, use "cloud computing," since its software does not require installation, this fact is not a distinctive feature of its services nor a useful description of any characteristic of the product.

"A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed.Cir.2007) (citing *In re Gyulay*, 820 F.2d 1216, 1217 (Fed.Cir.1987)). It is not enough that a mark convey information about a product, since "[o]ne

may be informed by suggestion as well as by description.” *In re Reynolds Metals Company*, 480 F.2d 902, 178 USPQ 296 (CCPA 1973). Instead, although a mark “need not recite each feature of the relevant goods or services in detail to be descriptive,” *In re Dial–A–Mattress Operating Corp.*, 240 F.3d 1341, 1346 (Fed.Cir.2001), the connection between the mark and the goods or services described needs to be straightforward enough that “knowledge” about some characteristic or feature is conveyed “immediately” and without resort to analysis or speculation. Indeed, if “the mental leap between the word and the product's attributes is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness.” J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 11:67 (4th Ed. 1999). For example, if the relationship between the mark and the product is susceptible to multiple plausible interpretations, the mark is best characterized as suggestive. *See, e.g. Anheuser-Busch, Incorporated v. Kelly J. Holt*, Opp. No. 91180119 (T.T.A.B. 2009) (denying 2(e) opposition of ONE BEER, BEER 1 and noting that consumers might regard the phrase as describing the beer’s market position but might also regard the phrase as describing the beer’s uniqueness).

“The cloud” is simply a metaphor for the Internet. *See, e.g.* App. NOR, Exhibit 13 (“As a metaphor for the Internet, ‘the cloud’ is a familiar cliché . . .”). While the term “cloud computing” may have certain technical implications to IT professionals, (App. NOR, Exhibit 16), to the public at large it remains, at best, a buzzword suggesting Internet savviness. *See* App. NOR, Exhibit 14 (lamenting the transformation of “cloud computing” from a technical description to a meaningless marketing phrase); App. NOR, Exhibit 16 (“51% [of Americans surveyed] believe stormy weather would interfere with their cloud computing”). Since nearly any Internet-based activity—from performing a search on Google to checking your bank statement online—could be described as a form of “cloud computing,” consumers are likely to regard the

term CLOUD in the same way that they regard the term “digital” or the prefix “e,” not as a description of how a particular service operates but rather as a suggestion that the service is somehow cutting-edge.

Applicant intends to introduce a service allowing customers to store, organize and retrieve large amounts of data. Since this process will not require the installation of any software on customers’ computers, it could be described as utilizing “cloud computing.” However, there is nothing distinctive about the fact that Applicant’s services utilize remote servers, a characteristic by definition shared with every online service. Therefore, even if a consumer were savvy enough to guess that the CLOUD portion of PRESERVATION CLOUD referred to cloud computing, this would tell you very little about the nature of the services.

To experienced IT professionals, the term “cloud” might imply that Nextpoint’s Data Management Service has certain technical aspirations: that it’s able to operate on a “multi-tenant basis,” for example, and that it’s “able to scale programmatically on both storage and processing.” Madhava Dep. 12:4-17 (describing Nextpoint’s understanding of the term “cloud” internally). The legal professionals to whom Nextpoint intends to market the service, however, have only a “very broad” understanding of cloud computing and are “not generally familiar with most of the concepts involved.” Madhava Dep. 13:1-12. To the primary consumers of litigation support software, the word “cloud” is likely to do little more than suggest that Nextpoint’s services have a fashionable, cutting-edge association with the Internet. The word does not convey any immediate knowledge concerning any salient characteristic of Preservation Cloud and therefore cannot be considered descriptive.

B. PRESERVATION CLOUD is a unitary expression that lacks any readily ascertainable meaning.

“The commercial impression of a trademark is derived from it as a whole rather than by

reference to its individual parts.” *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 528, 545-546 (1920). Therefore, under the “anti-dissection rule,” a composite mark can be suggestive or fanciful even if composed of words that are merely descriptive. *McCarthy, supra*, § 11:26. The test is whether a mark taken as a whole has descriptive meaning. *See, e.g. Galaxy Metal Gear, Inc. v. Direct Access Technology, Inc.*, Opp. No. 91184213 (T.T.A.B. 2010) (denying 2(e) opposition and finding that METAL GEAR taken as a whole was not descriptive of computer “gear” made of metal); *In re Fazzari Restaurant Group LLC*, Ex Parte Appeal No. 77109197 (T.T.A.B. 2010) (reversing 2(e) refusal and finding that MARGARITA COMPANY taken as a whole was not descriptive of a restaurant company that specialized in margaritas); *In re K2, Inc.*, Ex Parte 75916474 (TTAB 2003) (reversing 2(e) refusal and finding that STORM BOARDS as a whole was not descriptive of weather-resistant wall boards).

The term “preservation cloud” has no established meaning. There is, simply put, no such thing as a “preservation cloud.”

In alleging that PRESERVATION CLOUD “merely describes Nextpoint’s use of cloud computing for the preservation of certain types of data found on the internet,” Opposer implies that consumers regard an “x cloud” as a service using cloud computing to do *x*, as in “Google is the leading search cloud” or “I’m looking for a good accounting cloud to file my taxes.” However, the large number of registered trademarks making use of the pattern “x cloud” or some variation thereon suggests that the consuming public does not interpret the word “cloud” in this way. These marks include:

Mark	Registration No.	Owner	Goods/Services	App. NOR Exhibit
INVESTCLOUD	4179263	Investcloud, LLC	Class 42: Cloud computing featuring software for use in management	17

			and storage of financial information	
EVENTCLOUD	4170485	InXpo, Inc.	Class 42: Computer services, namely, providing temporary use of non-downloadable computer software for the purpose of conducting interactive virtual and virtual-live hybrid business meetings, tradeshow, conferences, webcasts conferences, symposiums, expositions, seminars, training programs, online education programs, product launches, corporate briefings, job fairs, lead generation activities, industry networking programs, business networking programs, video streaming, online education programs and combinations thereof.	18
INVOICECLOUD	4166013	Invoice Cloud, Inc.	Class 35: Electronic invoice presentment, BEING INVOICING SERVICES Class 36: Bill payment services; Check processing; Credit card and payment card services; Electronic payment, namely, electronic processing and transmission of bill payment data; Providing electronic processing of automated clearing house (ACH), electronic check and credit card transactions and electronic payments via a global computer network; Providing electronic processing of electronic funds transfer, ACH, credit card, debit card, electronic check and electronic payments	19
CLOUDPASSAGE	4086875	CloudPassa	Class 42:	20

		ge, Inc.	Computer services, namely, ensuring computer security by restricting network access to computers, controlling computer operating system and application security configuration parameters, monitoring and managing access rights and privileges to computers, and monitoring for intrusions and proactively reconfiguring computer operating system and application security configuration parameters to stop detected intrusions; cloud computing services, namely, providing software as a service (SaaS) services, namely, hosting software for use by others for providing security for cloud computer services, namely, security for public, private and hybrid cloud servers and for cloud hosting environments, and infrastructure-as-a-service (IaaS) services, namely, hosting one or more virtual computers for use by others for providing security for cloud computer services, namely, security for public, private and hybrid cloud servers and for cloud hosting environments; computer consultation in the field of cloud computer security.	
SERVICECLOUD	4232147	Salesforce.com, Inc.	Class 35: BUSINESS MANAGEMENT SERVICES, NAMELY, PROVIDING INFORMATION, DATA ASSET, AND IDENTITY MANAGEMENT SERVICES; COMPILATION AND MANAGEMENT OF COMPUTERIZED DATABASES AND CONSULTING SERVICES RELATED THERETO; BUSINESS MANAGEMENT	21

			<p>SERVICES, NAMELY, PROVIDING CUSTOMER RELATIONSHIP MANAGEMENT SERVICES AND SALES SUPPORT MANAGEMENT SERVICES; BUSINESS MANAGEMENT CONSULTING SERVICES RELATING TO CUSTOMER RELATIONSHIP MANAGEMENT, SALES SUPPORT MANAGEMENT, AND MARKETING AUTOMATION; PROVIDING A WEBSITE FEATURING INFORMATION IN THE FIELDS OF ADVERTISING, MARKETING, AND BUSINESS MANAGEMENT, AND CONSULTING SERVICES RELATED THERETO; OPERATING ONLINE MARKETPLACES FOR BUYING AND SELLING, SHARING, AND OFFERING FOR FREE COMPUTER SOFTWARE AND ON-DEMAND APPLICATIONS</p> <p>Class 42: PROVIDING TEMPORARY USE OF ON-LINE NON-DOWNLOADABLE SOFTWARE TO STORE, MANAGE, TRACK, ANALYZE, AND REPORT DATA IN THE FIELD OF MARKETING, PROMOTION, SALES, CUSTOMER INFORMATION, CUSTOMER RELATIONSHIP MANAGEMENT, SALES SUPPORT AND EMPLOYEE EFFICIENCY; PROVIDING TEMPORARY USE OF ON-LINE NON-</p>	
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			<p> DOWNLOADABLE SOFTWARE TO FACILITATE COMMUNICATING AMONG PEER PROFESSIONALS IN THE ADVERTISING, MARKETING AND BUSINESS SERVICES FIELDS, AND FOR CUSTOMIZING COMPUTER APPLICATION USER INTERFACES; COMPUTER SERVICES, NAMELY, DESIGNING, DEVELOPING, AND MAINTAINING COMPUTER SOFTWARE APPLICATIONS FOR OTHERS AND CONSULTING SERVICES RELATED THERE TO; PROVIDING TEMPORARY USE OF ONLINE NON- DOWNLOADABLE COMPUTER SOFTWARE APPLICATION DEVELOPMENT TOOLS AND PROGRAMMING LANGUAGE FOR USE IN DEVELOPING, ANALYZING, CODING, CHECKING, AND CONTROLLING OTHER COMPUTER SOFTWARE; PROVIDING TEMPORARY USE OF ONLINE NON- DOWNLOADABLE COMPUTER SOFTWARE THAT IMPLEMENTS A PROCEDURAL AND OBJECT-ORIENTED PROGRAMMING LANGUAGE; ONLINE HOSTED COMPUTER SERVICES, NAMELY, DESIGNING, DEVELOPING, CUSTOMIZING, AND MAINTAINING COMPUTER SOFTWARE APPLICATIONS FOR OTHERS, </p>	
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			AND CONSULTING SERVICES RELATED THERETO Class 45: ON-LINE SOCIAL NETWORKING SERVICES	
IMAGECLOUD	4180954	Kress Stein	Class 42: Providing on-line non- downloadable software for collecting, moving, storing and sharing images.	22
LABCLOUD	4058742	The Weaver Group, Inc.	Class 42: Software as a service, namely, hosting software for use by others in the field of inventory management and laboratory test data management.	23
CLOUD FOR COURTS	4111866	Cloud For Courts, LLC	Class 42: Software as a service (SaaS) services featuring applications for case management and statistics, case record-keeping, scheduling, calendaring, document management, image management and fiscal accounting and management.	24

The above marks were all registrable because, even though CLOUD might arguably refer to their connection to cloud computing, the marks as a whole are not phrases that consumers would regard as descriptive. A web-based service facilitating investing is not an “invest cloud.” A web-based service for planning events is not an “event cloud.” A web-based service for presenting invoices is not an “invoice cloud.” A web-based service helping professionals provide various services is not a “service cloud.” A web-based service for managing labs is not a “lab cloud.” A web-based service organizing images is not an “image cloud.” A web-based service for courts is not described as a “cloud for courts.” Similarly, a web-based service that stores and manages data cannot sensibly be described as a “preservation cloud.”

Therefore, even if “cloud” and “preservation” are found individually to provide some

vague insight into the general nature of Applicant's services, PRESERVATION CLOUD itself is an unfamiliar phrase with no established meaning, and it does not serve as a satisfying descriptor of any particular type of service.

C. Any doubts regarding the descriptiveness of the mark should be resolved in favor of the Applicant.

“Because the line between merely descriptive and only suggestive terms is ‘so nebulous,’ the Trademark Board takes the position that doubt is resolved in favor of the applicant.” *McCarthy, supra*, §11.51, quoting *In re Gourmet Bakers, Inc.*, 173 U.S.P.Q. 565 (T.T.A.B. 1972).

This reasoning has been followed in many cases. For instance, in *In re Penwalt Corp.*, 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972), the Trademark Trial and Appeal Board noted that although the conclusion that DRI-FOOT was not descriptive of foot deodorant was not “free from doubt . . . the doubt should be resolved in favor of the applicant.” *Id. See also, In re Women's Publishing Co.*, 23 U.S.P.Q.2d 1876, 1877 (T.T.A.B. 1992) (noting that “in accordance with precedent, we must resolve any reasonable doubt in favor of applicant”); *In re Merrill Lynch, Pierce, Fenner and Smith*, 4 U.S.P.Q.2d 1141, 1144 (Fed. Cir. 1987) (“It is incumbent on the Board . . . to resolve reasonable doubt in favor of the applicant, in accordance with practice and precedent.”). Therefore, should any uncertainty linger about the descriptiveness of PRESERVATION CLOUD, the doubt should be resolved in Applicant's favor.

Conclusion

Opposer has not carried its burden of demonstrating either that Nextpoint lacked a genuine intent to use PRESERVATION CLOUD when it filed its trademark application or that the term “preservation cloud” provides knowledge about Nextpoint's Data Management Service with such immediacy that it is merely a description of that service.

Even if Opposer's abandonment-of-intent argument were a valid basis for opposition, it has failed to demonstrate an absence of documentary evidence or to prove that any other circumstances exist that would suggest an abandonment of intent. Its argument, indeed, seems to rest exclusively on its unfounded speculation that Nextpoint's Data Management Service and its Web Archiving Service are a single product that Nextpoint intends to market exclusively as CLOUSPRESERVATION.

Meanwhile, Opposer has presented no evidence to contradict the Examining Attorney's determination that consumers of litigation support tools are unlikely to regard the term "preservation cloud" as merely a description of a software service for managing legacy ESI. PRESERVATION CLOUD is at best suggestive of such a service since the term "cloud" is broad, ambiguous and susceptible to many interpretations in the context of the Data Management Service and the term "preservation cloud" has no readily ascertainable meaning whatsoever.

For the foregoing reasons, this opposition proceeding should be terminated and Applicant's PRESERVATION CLOUD mark allowed to proceed to registration.

Respectfully submitted,

Respondent, Nextpoint, Inc.

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CERTIFICATE OF SERVICE

I, Daliah Saper, an attorney, hereby certify that on May 6, 2013 I served a copy of the foregoing Applicant's Trial Brief via electronic mail and first class mail to:

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